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OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER STOREY, WILLIAM C	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/658,778

Applicant(s)

HAYASHI ET AL.

Examiner

WILLIAM C. STOREY

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-26 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s), including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 26 is objected to under 37 CFR 1.75(a), which states that the specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper form.

Applicant claims determining whether "by facsimile forwarding instruction or the destination corresponding to the senders registered by the registering unit." However, the specification does not prove the two alternatives to be mutually exclusive. The examiner suggests the use of "and/or" instead of "or" in the phrase discussed above.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 16 & 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant claims conducting facsimile-forwarding "after the facsimile-forwarding has been suspended until the forwarding time specified by the specifying unit." However, the originally-filed specification did not disclose conducting facsimile-forwarding after suspension until a specified end time.

However, the specification does talk of a specified time acting as a start time for facsimile forwarding, and this interpretation shall be used for the discussion of the claims below.

3. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant claims "a selection unit that selects a facsimile-forwarding destination specified by the facsimile-forwarding instruction when the first determining unit determines that the facsimile-forwarding is instructed and selects a facsimile-forwarding destination corresponding to the senders registered by the registering unit when the second determining unit determines that the sender of the email is within the senders registered by the registering unit." However, this wording is contentious. In the specification, it talks of how if a destination is both instructed by email and is registered, the instruction of the email will reign; or, talks of how the email instructed destination address must be registered to the sender. However, the wording of this limitation runs counter to the specification. It is possible that a sender be both registered and instructed by email the destination. In addition, it does not disclose in the specification submitted at the time of filing, a destination being selected solely by checking whether the sender of the message is registered or not. For the purposes of the following discussion of the claim, the examiner will assume the applicant to mean a selection unit that selects a facsimile-forwarding destination specified by the facsimile-

forwarding instruction when the first determining unit determines that the facsimile-forwarding is instructed by email and selects a facsimile-forwarding destination corresponding to the senders registered by the registering unit when the second determining unit determines that the sender of the email is within the senders registered by the registering unit, there is a referral to a corresponding destination, and the first determining unit determines that the facsimile-forwarding is not instructed by email without a corresponding stored destination.

4. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 26 claims "the reporting unit saves the facsimile-forwarding data converted by the converting unit and sends a report reporting that the facsimile-forwarding data was saved by an email to the sender of the email." However, the specification provided as of the original filing date contains no mention of saving and then sending an email reporting the saving to the sender of the email when there is a transmission failure. The specification talks of faxing an "accumulation" report to the facsimile destination. For the purpose of the following discussion of the claim, the examiner will assume the applicant to mean sending a facsimile to the facsimile destination, as talked about above, instead of sending an email to the sender of the email.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 13-14 & 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaufeld et. al (US 5859967), hereinafter referred to as Kaufeld.

Regarding claim 13, Kaufeld discloses an image communication apparatus, comprising: an email receiving unit that receives an email (column 3, lines 31-36. The transmission computer reads on claimed email receiving unit and receives email.); an analyzing unit that analyzes the email received by the email receiving unit (column 3, lines 35-42 discloses the transmission computer checking over the received email, reads on claimed analyzing); a determining unit that determines whether facsimile-forwarding is instructed by the email analyzed by the analyzing unit (column 6, lines 45-48 disclose addressing the email to the destination number of the facsimile machine to which the message is to be delivered. column 3, lines 35-42 disclosed the transmission computer sending the email to a facsimile machine. column 7, lines 13-18 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Figures 4 & 6 disclose the fax number from the email used for the received fax sending. Transmission computer does the converting and analyzing, thus reading on the determining unit in the process in order to glean the fax number.); a converting unit that converts the email into facsimile-

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forwarding data if the determining unit determines that the facsimile-forwarding is instructed (As has been discussed above and at column 3, lines 38-42, the transmission computer, reading on claimed converting unit, converts the email into a fax and sends the email to the fax number instructed in the email.); a setting unit that sets an upper limit for facsimile-forwarding the email (column 8, lines 57-59 discloses the use of a transmit counter. Column 9, lines 9-20 disclose that once the counter exceeds a predetermined number, which reads on claimed upper limit; the attempts to fax-forward will cease. Fig 8c. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37) and thus, reads on claimed setting unit.); and a forwarding control unit that conducts facsimile-forwarding of the facsimile-forwarding data converted by the converting unit to a facsimile-forwarding destination specified by the facsimile-forwarding instruction when the facsimile-forwarding data converted by the converting unit does not exceed the upper limit set by the setting unit (The transmission computer performs the above and thus, reads on claimed forwarding control unit. Fig. 8c shows the attempt of fax transmission for the process described previously. Fig. 8c shows the fax transmission allowed to proceed if the counter is below the predetermined number, which reads on claimed does not exceed the upper limit. This and the previous disclosures read on preceding limitation.)

Regarding claim 14, Kaufeld discloses everything applied above for claim 13. In addition, Kaufeld discloses a forward stopping control unit that stops facsimile-forwarding of the facsimile-forwarding data converted by the converting unit when the facsimile-forwarding data converted by the converting unit exceeds the upper limit (It

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was disclosed above how the fax transmission attempts are ceased, which reads on claimed stops facsimile forwarding; once the counter exceeds the predetermined value. Transmission computer reads on claimed forward stopping control unit for reasons disclosed above.); and a reporting unit that sends a report of facsimile-forwarding failure by an email to a sender of the email when the facsimile-forwarding of the facsimile-forwarding data was stopped by the forward stopping control unit (Column 9, lines 9-20, fig. 8c, disclose that once no further attempts at fax transmission are to be made, an email is sent back to the sender indicating that the facsimile transmission was not successfully transmitted. In addition, details as to why are included. All of this reads on claimed report of facsimile-forwarding failure. Transmission computer reads on claimed reporting unit for reasons disclosed above.)

Regarding claim 16, Kaufeld discloses everything as applied above for claim 13. In addition, Kaufeld discloses that if an attempt to send fails and that the transmit counter has not exceeded the predetermined value, the system waits a predetermined period of time in order to attempt to send the fax again (column 9, lines 4-9). It would be obvious to one of ordinary skill in the art at the time the invention was made to send the fax regularly until the counter limit is reached and then wait the predetermined period of time for the purpose of using the wait time as the solution to the limit being reached, and allow a chance for immediate resolve up to the limit, and then wait in order to see if delaying the transmission will solve the problem. The transmission computer reads on claimed specifying unit.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufeld as applied above for claim 13 in view of Najafi (US 5442457).

Regarding claim 15, Kaufeld discloses everything applied above for claim 13. However, Kaufeld fails to disclose a splitting unit that splits facsimile data into a plurality of the facsimile data; and a split forwarding unit that forwards the plurality of the facsimile data split by the splitting unit to the facsimile destination one after another. However, the examiner maintains that it was well known in the art to provide a splitting unit that splits facsimile data into a plurality of the facsimile data; and a split forwarding unit that forwards the plurality of the facsimile data split by the splitting unit to the facsimile destination one after another, as taught by Najafi.

In a similar field of endeavor, Najafi discloses a multi-line pooling facsimile apparatus. In addition, Najafi discloses a CPU 13, which reads on claimed splitting unit and split forwarding unit; that divides, which reads on claimed splits; the fax data into shares or portions, which reads on claimed plurality of facsimile-forwarding data; and sends, which reads on claimed forwards; the data using separate lines from one fax machine to a similar fax machine, which reads on claimed facsimile-forwarding destination; that may reassemble the data at the other end, as disclosed in Figure 2 and

column 3, lines 27-33. It is inherent to provide sending packeted data one after another for the purpose of allowing a computer or processor to work with the data (even in a parallel format).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaufeld by specifically providing a splitting unit that splits facsimile data into a plurality of the facsimile data; and a split forwarding unit that forwards the plurality of the facsimile data split by the splitting unit to the facsimile destination one after another, as taught by Najafi, for the purpose of making the transmission of fax data more resilient to some errors, like being disconnected during the middle of a transmission.

The splitting and forwarding may be done when a limit is reached, like a # of attempts to send (as previously taught by Kaufeld), so that a disconnection or some other error might be able to be avoided. Kaufeld previously taught converting. Kaufeld previously taught facsimile-forwarding. Facsimile-forwarding data is facsimile data.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufeld as applied above for claim 13 in view of Eguchi (US 6982803).

Regarding claim 17, Kaufeld discloses everything as applied above for claim 13. However, Kaufeld fails to disclose data size as an upper limit. However, the examiner maintains that it was well known in the art to provide data size as an upper limit, as taught by Eguchi.

In a similar field of endeavor, Eguchi discloses a facsimile server, electronic mail device, and communication method. In addition, Eguchi discloses data size as an

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upper limit (Eguchi discloses a RAM 21, which the capacity of is a designated value, which reads on claimed upper limit based on a data size of data; as disclosed at Figure 2 and column 4, line 15, and column 5, line 2-4. Eguchi discloses the when the data size for transmission is larger than the designated value, the facsimile server 2 does not receive the electronic mail from the electronic mail box, hence preventing transmission, as opposed to when the data size is smaller and the electronic mail is received as usual, thereby allowing fax transmission, as disclosed at Figure 2 and column 5, lines 4-7, lines 11-16, 22-37.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaufeld by specifically providing data size as an upper limit, as taught by Eguchi, for the purpose of preventing problems.

Kaufeld has taught facsimile-forwarding data and converting, as well as setting an upper limit. Now, Eguchi has taught setting an upper limit based on data size of transmission.

6. Claims 18-20, 22, & 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufeld as applied above for claim 13 in view of Okutomi et al. (US 6211972), hereinafter referred to as Okutomi.

Regarding claim 18, Kaufeld discloses everything as applied above for claim 13. However, Kaufeld fails to disclose limiting by page size. However, the examiner maintains that it was well known in the art to provide limiting by page size, as taught by Okutomi.

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In a similar field of endeavor, Okutomi discloses an electronic mail converting apparatus for facsimile. In addition, Okutomi discloses a LAN controlling section that compares the number of fax sheets to be produced from an email with the maximum number of sheets the fax machine has to output, as disclosed at column 6, lines 48-51 and 61-66. The maximum number of sheets the fax machine has to output reads on upper limit based on a number of pages. If the maximum number of sheets the fax machine has to output is less than the number of email pages, then the transmission is limited, as disclosed in column 6, lines 66-67 and column 7, lines 1-4 and 14-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaufeld by specifically providing limiting by page size, as taught by Okutomi, for the purpose of saving cost, as disclosed in column 7, lines 21-23.

Regarding claim 19, Kaufeld discloses an email receiving unit that receives an email (column 3, lines 31-36. The transmission computer reads on claimed email receiving unit and receives email.); an analyzing unit that analyzes the email received by the email receiving unit (column 3, lines 35-42 discloses the transmission computer checking over the received email, reads on claimed analyzing); a registering unit that registers senders whose emails are permitted to be facsimile-forwarded and facsimile-forwarding destinations (column 4, lines 58-65 disclose registering a user's email address and column 3, lines 36-38 disclose checking to see if there is a valid email address. Column 7, lines 43-51 disclose checking for a valid email address and stopping the flow for forwarding transmission if the sender's address is not valid. A

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computer corresponds with a registering unit. (figure 3, column 3, lines 44-46) column 10, lines 54-60 disclose that a user may register destination address(es) that may be registered as a name or name list.); a determining unit that determines whether a sender of the email analyzed by the analyzing unit is registered by the registering unit (Transmission computer reads on claimed determining unit. It was disclosed above how the email address of the sender is checked to be valid, and acted upon accordingly (fig. 8a)); a converting unit that converts the email into facsimile-forwarding data when the sender of the email is registered by the registering unit (column 7, lines 13-18, column 3, lines 38-42 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Fig. 8a-8b show that in order for the email to be converted to fax, the email sender must have a valid account. Transmission computer reads on claimed converting unit.); a setting unit that sets an upper limit for conducting facsimile-forwarding of an email (column 8, lines 57-59 discloses the use of a transmit counter. Column 9, lines 9-20 disclose that once the counter exceeds a predetermined number, which reads on claimed upper limit; the attempts to fax-forward will cease. Fig 8c. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37) and thus, reads on claimed setting unit.); and a forwarding control unit that conducts facsimile-forwarding of the facsimile- forwarding data converted by the converting unit to a facsimile-forwarding destination corresponding registered by the registering unit when the facsimile-forwarding data converted by the converting unit does not exceed the upper limit set by the setting unit (The transmission computer performs the above and

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thus, reads on claimed forwarding control unit. Fig. 8c shows the attempt of fax transmission for the process described previously. Fig. 8c shows the fax transmission allowed to proceed if the counter is below the predetermined number, which reads on claimed does not exceed the upper limit. This and the previous disclosures read on preceding limitation. It was disclosed above how the user may register destination addresses for receipt of a facsimile transmission.).

The examiner maintains that it was well known in the art to provide corresponding the destinations to the senders, as taught by Okutomi.

Okutomi discloses corresponding the destinations to the senders (column 3, lines 28-30, fig. 6 disclose storing a correspondence table of e-mail addresses and telephone numbers. Column 6, lines 6-12 goes further to include extracting the sender's address, corresponding it to an address book and transmitting it to a corresponding telephone number for receiving a facsimile transmission. Column 5 lines 54-61 also includes the ability to correspond a list of address as an address book. It would be obvious to correspond multiple addresses to a sender in the same way as for one for the purpose of consolidation.).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaufeld by specifically providing corresponding the destinations to the senders, as taught by Okutomi, for the purpose of not allowing other senders "open directory access" to destination addresses that a particular sender has registered.

Regarding claim 20, this claim inherits everything as applied above from claim 19. In addition, claim 20 is rejected based upon similar reasoning as applied above for claim 14.

Regarding claim 22, this claim inherits everything as applied above from claim 19. In addition, claim 22 is rejected based upon similar reasoning as applied above for claim 16.

Regarding claim 24, this claim inherits everything as applied above from claim 19. In addition, claim 24 is rejected based upon similar reasoning as applied above for claim 18.

Regarding claim 25, Kaufeld discloses an email receiving unit that receives an email (column 3, lines 31-36. The transmission computer reads on claimed email receiving unit and receives email.); an analyzing unit that analyzes the email received by the email receiving unit (column 3, lines 35-42 discloses the transmission computer checking over the received email, reads on claimed analyzing); a registering unit that registers senders whose emails are permitted to be facsimile-forwarded and facsimile-forwarding destinations (column 4, lines 58-65 disclose registering a user's email address and column 3, lines 36-38 disclose checking to see if there is a valid email address. Column 7, lines 43-51 disclose checking for a valid email address and stopping the flow for forwarding transmission if the sender's address is not valid. A computer corresponds with a registering unit. (figure 3, column 3, lines 44-46) column 10, lines 54-60 disclose that a user may register destination address(es) that may be registered as a name or name list.); a first determining unit that determines whether

facsimile-forwarding is instructed by the email analyzed by the analyzing unit (column 6, lines 45-48 disclose addressing the email to the destination number of the facsimile machine to which the message is to be delivered. column 3, lines 35-42 disclosed the transmission computer sending the email to a facsimile machine. column 7, lines 13-18 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Figures 4 & 6 disclose the fax number from the email used for the received fax sending. Transmission computer does the converting and analyzing, thus reading on the determining unit in the process in order to glean the fax number.); a second determining unit that determines whether a sender of the email analyzed by the analyzing unit is registered by the registering unit (Transmission computer reads on claimed determining unit. It was disclosed above how the email address of the sender is checked to be valid, and acted upon accordingly (fig. 8a)); a converting unit that converts the email into facsimile-forwarding data when the first determining unit determines that the facsimile-forwarding is instructed (column 7, lines 13-18 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Figures 4 & 6 disclose the fax number from the email used for the received fax sending. Previously disclosed, column 3, lines 38-42, the transmission computer, reading on claimed converting unit, converts the email into a fax and sends the email to the fax number instructed in the email.) or when the sender of the email is registered by the registering unit (column 7, lines 13-18, column 3, lines 38-42 disclose that the email is converted to a facsimile from the email and the facsimile is

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automatically generated and originated from information in the email. Fig. 8a-8b show that in order for the email to be converted to fax, the email sender must have a valid account. Transmission computer reads on claimed converting unit.); a setting unit that sets an upper limit for conducting facsimile-forwarding of an email (column 8, lines 57-59 discloses the use of a transmit counter. Column 9, lines 9-20 disclose that once the counter exceeds a predetermined number, which reads on claimed upper limit; the attempts to fax-forward will cease. Fig 8c. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37) and thus, reads on claimed setting unit.);

The examiner maintains that it was well known in the art to provide corresponding the destinations to the senders and, as taught by Okutomi.

Okutomi discloses corresponding the destinations to the senders (column 3, lines 28-30, fig. 6 disclose storing a correspondence table of e-mail addresses and telephone numbers. Column 6, lines 6-12 goes further to include extracting the sender's address, corresponding it to an address book and transmitting it to a corresponding telephone number for receiving a facsimile transmission. Column 5 lines 54-61 also includes the ability to correspond a list of address as an address book. It would be obvious to correspond multiple addresses to a sender in the same way as for one for the purpose of consolidation.).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaufeld by specifically providing corresponding the destinations to the senders, as taught by Okutomi, for the purpose of not allowing

other senders "open directory access" to destination addresses that a particular sender has registered.

Kaufeld and the disclosure of Okutomi disclose a selection unit that selects a facsimile-forwarding destination specified by the facsimile-forwarding instruction when the first determining unit determines that the facsimile-forwarding is instructed (Kaufeld discloses that the user may specify a destination without a referral to a stored destination by email, as disclosed above by specifying a specific fax number in the to address of the email.) and selects a facsimile-forwarding destination corresponding to the senders registered by the registering unit when the second determining unit determines that the sender of the email is within the senders registered by the registering unit (It was also disclosed above (and at column 10, lines 54-60) how the user may alternatively refer to a stored (registered) destination or destination list by name. It was disclosed above by Okutomi how a sender's address is checked for registration and then sent to an associated facsimile destination. The transmission computer reads on claimed selection unit, as it performs the processes of receiving, processing and transmitting the email/facsimiles as has been discussed previously.) (Please note the discussion under the claim rejections section above.); and a forwarding control unit that conducts facsimile-forwarding of the facsimile-forwarding data converted by the converting unit to a facsimile-forwarding destination selected by the selection unit when the facsimile-forwarding data converted by the converting unit does not exceed the upper limit set by the setting unit ((The transmission computer performs the above and thus, reads on claimed forwarding control unit. Fig. 8c shows the

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attempt of fax transmission for the process described previously. Fig. 8c shows the fax transmission allowed to proceed if the counter is below the predetermined number, which reads on claimed does not exceed the upper limit. This and the previous disclosures read on preceding limitation. It was disclosed above how the user may register destination addresses for receipt of a facsimile transmission. The discussion of transmission allotted by the selection unit is also disclosed above.).

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufeld in view of Okutomi as applied above for claim 19 and further in view of Najafi.

Regarding claim 21, this claim inherits everything as applied above from claim 19. In addition, claim 21 is rejected based upon similar reasoning as applied above for claim 15.

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufeld in view of Okutomi as applied above for claim 19 and further in view of Eguchi.

Regarding claim 23, this claim inherits everything as applied above from claim 19. In addition, claim 23 is rejected based upon similar reasoning as applied above for claim 17.

9. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufeld in view of Okutomi as applied to claim 25 and further in view of Eguchi and Ray (US 2004/0128207).

Regarding claim 26, Kaufeld and Okutomi disclose everything as applied above for claim 25. In addition, Kaufeld and the previous disclosure of Okutomi disclose a third determining unit that determines whether or not the facsimile-forwarding by the

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forwarding control unit was successful (column 8, lines 57-59 discloses the use of a transmit counter. Column 9, lines 9-20 disclose that once the counter exceeds a predetermined number, which reads on claimed upper limit; the attempts to fax-forward will cease. Fig 8c. Thus, when the transmit counter limit has been exceeded the system knows that the transmission has been unsuccessful. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37) and thus, reads on claimed third determining unit.); a fourth determining unit that determines whether the facsimile-forwarding destination selected by the selection unit is either the destination specified by the facsimile-forwarding instruction and/or the destination corresponding to the senders registered by the registering unit (It has been disclosed previously how Kaufeld discloses being able to extract a specific destination address from an email, which reads on claimed destination specified by the facsimile-forwarding instruction; and how Kaufeld shows referencing a stored destination through a name or name list that is corresponded as taught by Okutomi, which reads on claimed destination corresponding to senders registered by the registering unit. Therefore, Kaufeld discloses the two options working alternatively, and the system being able to determine when a name is referring to a registered address(es), which reads on claimed determines. The transmission computer performs the functions of converting, transmitting, etc. as discussed previously and thus, reads on claimed fourth determining unit.); and a reporting unit that sends a report of facsimile-forwarding failure by an email to the sender of the email when the third determining unit determines that the facsimile-forwarding was not successful and the fourth determining unit determines that the

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facsimile-forwarding destination selected by the selection unit is specified by the facsimile-forwarding instruction (column 9, lines 9-20 disclose sending an email back to the sender reporting that the facsimile transmission was unsuccessful and details as to why. Fig. 4, column 7, lines 43-44 disclose that the figs. 8a-8c, in which the previous disclosure is contained, are run through for an example of figure 4, where the instruction is set in the to line of the email, which reads on claimed facsimile-forwarding destination specified by the facsimile-forwarding instruction. Because of the "or" between the two limitations, this reads on the preceding and following limitations based on the location in the claim. Transmission computer reads on claimed reporting unit.),

However, the previous disclosures of Kaufeld and Okutomi fail to disclose deleting the forwarding data when there is a transmission failure. However, the examiner maintains that it was well known in the art to provide deleting the forwarding data when there is a transmission failure, as taught by Eguchi.

In a similar field of endeavor, Eguchi discloses a facsimile server, electronic mail device, and communication method. In addition, Eguchi discloses deleting the forwarding data when there is a transmission failure (Eguchi discloses a size limit for forwarding of an email. If the email size is too big, the user may select not to receive the item, to return a message to the sender, or forward it to a destination. If the setting is on return or forward, the memory where the message is received is cleared and the email is deleted from the electronic mail box (column 5, lines 11-41, 18-22, 32-34, & 39-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previous disclosures of Kaufeld and Okutomi by specifically providing deleting the forwarding data when there is a transmission failure, as taught by Eguchi, for the purpose of freeing up space in order to allow more messages to come in that might be able to be transmitted.

Kaufeld has taught previously converting email data to facsimile data by the time that the transmission is found to be unsuccessful. Therefore, the combination would read on claimed deletes the facsimile-forwarding data converted by the converting unit.

In addition, the previous disclosures fail to disclose saving an item for transmission and sending a facsimile report that it was saved to a destination. However, the examiner maintains that it was well known in the art to provide saving an item for transmission and sending a report that it was saved to a destination, as taught by Ray.

In a similar field of endeavor, Ray discloses systems and methods for providing item delivery notification. In addition, Ray discloses saving an item for transmission and sending a facsimile report that it was saved to a destination (Ray discloses a system for notifying recipients and/or senders about the transmission process of a package, for example. Ray discloses sending a notification, which reads on claimed; reporting that an item was not deliverable (as in the package was too big for the mailbox) and that it is being saved for the recipient available to be picked up at a central location, like a post office (§ 36, § 38), which reads on saving the item that is trying to be transmitted and sending a report that it was saved to a destination. In addition, Ray discloses

communication with the recipient over a communications system, like the internet (§ 23, 24). The communication to notify the recipient may take place by email or by facsimile, for example (§ 24), by a facsimile to a facsimile destination.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previous disclosures by specifically providing saving an item for transmission and sending a facsimile report that it was saved to a destination, as taught by Ray, for the purpose of allowing a recipient to know the transmission status of their facsimile delivery.

Kaufeld has taught previously converting email data to facsimile data by the time that the transmission is found to be unsuccessful. Therefore, the combination would read on claimed saves the facsimile-forwarding data converted by the converting unit.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

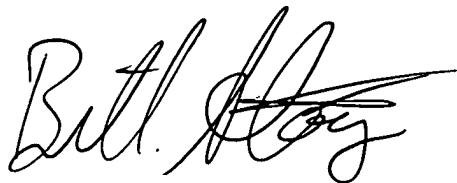
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM C. STOREY whose telephone number is (571)270-3576. The examiner can normally be reached on Monday - Friday Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



W. C. S./
Examiner, Art Unit 2625

William C Storey
Examiner
Art Unit 2625



GABRIEL GARCIA
PRIMARY EXAMINER